

REMARKS

This paper is being submitted in response to the Final Office Action mailed in the application on January 22, 2010. Claims 15-31 and 33 are pending. Claims 29 through 31 have been allowed. Claims 24-26 have been objected to as dependent on a rejected base claim, but indicated as allowable if rewritten in independent form. Claims 15-23, 27, 28, and 33 are rejected. Applicant respectfully requests reconsideration of claims 15-28 and 33 in view of the following remarks.

I. CLAIM REJECTIONS

35 USC § 102 (b) Rejections

Claims 15-21 and 27-28 stand rejected under 35 U.S.C. §102(b) as being anticipated by Farrar (U.S. Patent Application Publication 2004/0123311). Applicant respectfully traverses this rejection.

Claim 15 recites, in part, “the receptacle being configured and adapted to receive first and second surfaces of the article that are wider than the apparatus, such that the article when received in the receptacle may extend beyond the apparatus in the third direction and may extend beyond the apparatus in a fourth direction opposite the third direction.” The structure as recited in Claim 15 is not found in Farrar.

The Action alleges that Farrar’s Figure 6 shows an apparatus that leaves an article unrestrained in at least a third direction (the “axial” direction). The apparatus in question is identified in paragraph [0104] of the published application as “magnetic release device 25.” Except for paragraphs [0104], [0106] and [0109], element 25 is not otherwise discussed in Farrar (paragraph 114 incorrectly uses “25” to identify apertures “35” or “36”).

Farrar's Figure 6 is a cross section and depicts the local shape, not the overall shape, of "magnetic release device 25". The Action states that "Farrar et al. does not disclose that magnetic release device 25 bounds the device in any other directions other than those established by parts 25A and 25B, leaving one to conclude that it is inherent within the cited passage that the third and fourth directions are not restrained in any manner." Applicant questions how one can conclude, from a cross section drawing such as Figure 6, anything more than the local shape of the device at the location of the section. The cross section itself is not sufficient to conclude that the third and fourth directions are not restrained.

This is especially so because the only guidance Farrar gives with respect to this aspect of a release device is directly to the contrary. Elsewhere Farrar paragraph [0082] states that "Fig. 34 is a perspective, part cut-away, view (from in front and beneath) of a preferred embodiment of apparatus for releasing a security member according to the invention..." (emphasis added). Figs. 34 and 35 show an apparatus comprising a "slot 501" for receiving an edge of the container, and Fig. 36B shows the apparatus in one of several cross sections. Using the Action's logic as applied to Figure 6, it would appear from Figure 36B that one might "conclude that it is inherent...that the third and fourth directions are not restrained in any manner." However, this would be incorrect based on Figs. 34 and 35 as the release device shown in Figs. 34 and 35 clearly does not leave the article unrestrained in the third and fourth directions.

There is no structure shown to suggest that the Fig. 6 represents anything other than a local cross-section view. Farrar does not show a release device that leaves the article unrestrained in the axial direction. To conclude that it does requires the hindsight of Applicant's own disclosure. Thus Farrar does not anticipate claim 15. The failure of Farrar to disclose all of the elements of claim 15 precludes an anticipation rejection of claim 15. For at least the foregoing reason, Applicant

respectfully requests withdrawal of the 35 U.S.C. §102(b) rejection of claim 15 in light of Farrar.

Claims 17-21 and 28 depend from claim 15 and also are rejected as being anticipated by Farrar. However, if an independent claim is not anticipated by prior art, then its dependent claims, which necessarily include the limitations of the independent claim, are not anticipated either. *See Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1296 (Fed. Cir. 2002). The Farrar failure to anticipate claim 15 therefore precludes an anticipation rejection of dependent claims 17-21 and 28. Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(b) rejection of claims 17-21 and 28.

Claim 16 and its dependent claim - Claim 16 recites, in part, “wherein the receptacle is adapted and configured to receive the article such that the size of the surfaces of the article within the receptacle are unrestricted in at least the third direction and a fourth direction opposite the third direction.” As discussed above, Farrar does not disclose such a structure. The failure of the Farrar to disclose all of the elements of claim 16 precludes an anticipation rejection of claim 16. For at least the foregoing reason, Applicant respectfully requests withdrawal of the 35 U.S.C. §102(b) rejection of claim 16 in light of Farrar.

Claim 27 depends from claim 16 and also is rejected as being anticipated by Farrar. However, if an independent claim is not anticipated by prior art, then its dependent claims, which necessarily include the limitations of the independent claim, are not anticipated either. *See Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1296 (Fed. Cir. 2002). The Farrar failure to anticipate claim 16 therefore precludes an anticipation rejection of dependent claim 27. Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(b) rejection of claim 27.

35 USC § 103 (a) Rejections

Claim 21 is rejected under 35 USC 103(a) as being unpatentable over Farrar et al., as applied above, in view of Kim (US Patent 6,880,372). Applicant respectfully traverses this rejection. Claims 22-23 are rejected under 35 USC 103(a) as being unpatentable over Farrar et al. and Kim, as applied above, in view of Stelter (US Patent 6,084,498). Applicant respectfully traverses the rejections.

Claim 21 is dependent upon claim 15. As discussed above, claim 15 and its dependent claims are not anticipated by Farrar. Combining Farrar with Kim, or combining Farrar, Kim, and Stelter, still does not teach or suggest an apparatus of claim 15 which recites, in part, “the receptacle being configured and adapted to receive first and second surfaces of the article that are wider than the apparatus, such that the article when received in the receptacle may extend beyond the apparatus in the third direction and may extend beyond the apparatus in a fourth direction opposite the third direction.” The failure of the cited references to disclose all of the elements of claim 15 precludes an obviousness rejection of claim 15.

Claims 21, 22, and 23 depend from independent claim 15 which is not anticipated or obvious in light of the cited references. As dependent claims of a non-obvious independent claim, claims 21, 22, and 23 are also non-obvious. *See, M.P.E.P.* §2143.03 (*citing, In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)*) (“If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.”)). Therefore, claims 21, 22, and 23 are not obvious. Applicant respectfully requests withdrawal of the 35 U.S.C. §103(a) rejection of claims 21, 22, and 23.

III. ALLOWED CLAIMS

Applicant thanks Examiner for indicating that claims 29-31 are allowed and that claims 24-26 would be allowable if rewritten independent form including all the limitations of the base claim and any intervening claims.

CONCLUSION

Claims 15 – 31 and 33 are believed to be in condition for allowance, and an early notice thereof is respectfully requested. Should the Examiner determine that additional issues exist which might be resolved by a telephone conference, they are respectfully invited to contact the Applicant's undersigned representative.

The Director is hereby authorized to charge any additional fees or underpayments of fees under 37 C.F.R. §§ 1.16 and 1.17, or to credit any overpayments, to Deposit Account Number 13-2500. Applicant is a large entity.

Respectfully Submitted,

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